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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,057	06/26/2001	Roberto Alcantara Martins Zucchetti	32286R006	6856

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1619

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,057

Applicant(s)

ZUCCHETTI ET AL.

Examiner

Clinton Ostrup

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 20, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

Claims 1-6 are pending in this application.

#### ***Priority***

Priority to PCT/BR99/00072 and Brazilian Application Number PI 9803936-9, filed September 8, 1998, has been acknowledged.

#### ***Specification***

The use of several trademarks such as, CARBOPOL 1342<sup>TM</sup>, PARASOL 1789<sup>TM</sup>, and EUSOLEX 6300<sup>TM</sup>, have been noted in this application. They should be capitalized wherever they appears and be accompanied by their generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Objections***

Claims 2-6 are objected to because of the following informalities: Commas have been used as decimal points whereas the USPTO conventionally uses periods as decimal points. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for soybean lecithin and thickeners, does not reasonably provide enablement for "any soybean lecithin thickeners."

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification does not provide a written description with antecedent basis for the use of any lecithin thickeners in a composition, as claimed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 are rejected because of the phrases “such as” and “preferably.” These phrases render these claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 2 is confusing because of the phrase “is present at a composition of about.” Examiner assumes applicant intended to write, “is present in the composition at about.”

Claims 4 and 5 are confusing because it is unclear whether applicant intends to claim a different first group of microspheres or if they are modifying the first group of microspheres from preceding claims. Examiner respectfully suggests changing “a” to “the” to clarify what is being claimed.

Claim 5 is vague and indefinite because it is unclear what is meant by the following terms: skin structures, micronutrients of the skin, sensorial agents, and “Carbopol 1342 associated to trietanolamin.” These terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 5 contains the trademark/trade names PARASOL 1789<sup>TM</sup>, EUSOLEX 6300<sup>TM</sup>, and CARBOPOL1342<sup>TM</sup>. Where a trademark or trade

name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe solar protection factors and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6 are rejected under 35 U.S.C. 102(a, e) as being anticipated by Rinaldi et al **5,891,470**.

Rinaldi et al teach soft gel formulations comprising retinol-impregnated microparticles and ascorbic acid which may be present as ascorbic acid-impregnated microparticles and/or within the emulsion. See: col. 1, line 5 – col. 2, line 10 and abstract. The reference teaches how to make the microparticles and also describes how the retinol will frequently will be a commercial blend containing antioxidants such as, vitamin E. See: col. 3, line 39 – col. 4, line 56. The reference describes an emulsion formulation comprising amounts of retinol, ascorbic acid, and antioxidants in amounts which overlap those of instant claims 2-6. See: col. 6, line 29 – col. 7, line 41.

Rinaldi et al specifically teach combining ascorbic acid-impregnated particles and retinol-impregnated particles comprising a retinol blend, tocopheryl acetate, ascorbic acid, disodium EDTA, and propyl gallate, together to obtain a softgel capsule. See: col. 7, lines 42 – col. 9, line 30.

Therefore, Rinaldi et al clearly anticipate instant claims 1-6.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (Rinaldi et al, **6,228,894 B1** describes softgel compatible compositions comprising retinol-impregnated microparticles containing retinol and tocopheryl acetate, and ascorbic acid-impregnated particles, which may be used in other dispensing containers, such as be used in sachets, tubes, and airless pumps).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



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Clinton Ostrup  
Examiner  
Art Unit 1619

November 30, 2001



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SUPERVISORY PATENT EXAMINER  
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